

REMARKS

Claims 1-3, 5 and 7 stand rejected under 35 USC 103 on newly cited prior art. Favorable reconsideration of this application is respectfully requested for one or more of the reasons set forth below.

The Final Rejection is Premature

The Examiner is requested to withdraw the finality of the latest Office Action because Applicant's previously amendment did not necessitate the new grounds of rejection. On the contrary, Applicant's previous amendment merely clarified the claims to overcome informalities in the claim language. No substantive changes to the claims were made. Therefore, this is the first opportunity Applicants have had to review and discuss the newly cited references. Therefore the Examiner is requested to withdraw the finality of the previous Office Action.

Section 103

The only outstanding rejection is whether the claims are obvious in view of newly cited U.S. Patent No. 3,745,388 to Frederick, U.S. Patent No. 2,516,901 to Morrill and/or U.S. Patent No. 4,823,038 to Mitzutani. These section 103 rejections are respectfully traversed.

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness as required by *Graham v. John Deere Co.*, 148 USPQ 459

(1966) and MPEP § 2141. Specifically, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) *The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;*

(C) *The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and*

(D) Reasonable expectation of success is the standard with which obviousness is determined. MPEP § 2141.01

"In determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would of been obvious." MPEP § 2141.02 (emphasis in original); *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983). Moreover, "[d]istilling an invention down to the 'gist' or 'thrust' of an invention disregards the requirement of analyzing the subject matter 'as a whole.'" MPEP § 2141.02; *W.L. Gore & Assocs. Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983).

For example, the Examiner admits that the primary reference to Frederick does not show:

- A plurality of supporters fixedly mounted in a perpendicular direction to the circumference of the rotating shaft;
- The rotor having a plurality of magnets, each magnet having a magnet pole piece being arranged in parallel with respect to the shaft and located on an end of one of the plurality of supports; and

- Each coil receiving induced magnetic flux of the rotors.

Therefore, the Examiner must, without the benefit of hindsight, prove that the references suggest the desirability of changing the structure and mode of operation of Frederick in order to arrive at Applicant's invention. It is submitted that the Examiner has not met this burden of proof. There is no suggestion or motivation in Morrill or Frederick to exchange the bits and pieces of their respective motors. For example, the rotor of Morrill fails to disclose any stator at all. In addition, the rotor of Morrill includes short circuited windings 25 which surround the permanent magnets. Moreover, the direction of the magnets in Morrill appear to be opposite to those of Frederick. Therefore, it is unlikely that the rotor of Morrill could be used with success for Frederick's intended purpose.

In addition, none of the references disclose Applicant's preferred supporters as shown, for example, in Figure 3 of Applicant's specification. These supporters are cylinders which hold pairs of permanent magnets so that their opposite pole faces are parallel to the shaft 23. The pairs of magnets on adjacent supporters are reversed. Claim 7, for example, recites that "ends of each support having a pair of magnets mounted thereto" with each pair containing magnets of "opposite polarity" in which the "pole faces" extend "parallel to the axial direction of the shaft". Claim 7 goes on to recite that "adjacent magnet pairs having magnetic polarities which are reversed with respect to each other".

The same argument applies to the third reference, the '038 patent to Mitzutani". For example, Mitzutani, likewise, does not have a plurality of supports for holding

permanent magnet pairs which extend parallel to the shaft. In fact, the magnet pairs in Mitzutani appear to run perpendicularly to the axis of the shaft.

By way of his motor construction Applicant's machine generates a rectangular waveform in a manner which is not disclosed or suggested by the references. It is submitted that the Examiner is using a hindsight approach in order to piece together the various components of the references in order to support his burden of proof. The references do not suggest the desirability or provide the motivation to rebuild the various references in the manner suggested by the Examiner. Thus, the Examiner has failed to meet his burden to provide a *prima facie* case of obviousness.

For the reasons set forth above, it is believed that this application is now in condition for allowance and such action is respectfully requested. In the event that the Examiner believes that personal contact would be advantageous to the disposition of this case, he is requested to call the undersigned at his earliest convenience.

Respectfully submitted,

Dated: April 24, 2003

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